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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/553,424	
	Filing Date	April 19, 2000	
	First Named Inventor	Schneider, Luke V.	
	Art Unit	1653	
	Examiner Name	Samuel W. Liu	
Total Number of Pages in This Submission	1	Attorney Docket Number	020444-000400US

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Firm or Individual	Townsend and Townsend and Crew LLP Scott L. Aussenhus Reg. No. 42,271
Signature	
Date	April 28, 2003

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Luke V. Schneider

Application No.: 09/553,424

Filed: April 19, 2000

For: **METHODS FOR CONDUCTING
METABOLIC ANALYSES**

Examiner: Samuel W. Liu

Art Unit: 1654

RESPONSE TO RESTRICTION
REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is filed in response to the Restriction Requirement mailed March 26, 2003. The original deadline for response was April 26, 2003, which, because it fell on a Saturday, is extended until April 28, 2003. Accordingly, this response is timely filed.

The current restriction requirement is the second in a series of restriction/election requirements. Whereas the Primary Examiner originally handling the case required only a species election, the current restriction requirement is significantly more stringent. Not only does the current restriction requirement restrict the claims into two groups, it converts what was originally a species election into two additional restriction requirement.

Specifically, Applicants are required to elect between Group I (claims 1-26 and 36-38) and Group II (claims 27-35). Applicants are further required to: (i) restrict the claims to

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one of the substrates listed in claims 10 or 16, and (ii) restrict the claims with respect to one of the spectroscopic means listed in claims 21 and 38.

In response, Applicants make the following elections with traverse:

Group I (claims 1-26 and 36-38);

Substrate: nucleotides

Spectroscopic means: mass spectrometry

These elections are made with traverse for several reasons. First, restricting the claims to one of the substrate species listed in Markush claims 10 and 16 and to one of the spectroscopic means listed in Markush claims 21 and 38 is contrary to restriction practice as described in MPEP 803.02. This section of the MPEP makes clear that even when a Markush-type claim includes independent and distinct inventions (as the Office Action asserts is the case here) the Office should at most require a provisional election of a single species prior to examination on the merits. This practice strikes an appropriate balance between the concerns of the Office regarding administrative concerns and unduly burdensome examination, and the clear constitutional and statutory rights of an inventor to claim an invention as it is contemplated. Such a species election with respect to the substrate species was in fact the approach taken by the Primary Examiner previously handling the case. It is respectfully submitted that if any type of restriction is required with respect to the species listed in the Markush claims 10, 16, 21 and 38 that it should be a species election rather than an actual restriction. In short, the case should be handled along the lines of the original species election requirement.

Secondly, if the Office maintains the restriction with respect to the species listed in claims 10 and 16, it is requested that the Office at least examine the claims with respect to both nucleotides and nucleosides. In accordance with MPEP 803.02, the Office cannot require an election of a single species prior to examination on the merits if the members are sufficiently few in number or so closely related that a search and examination can be made without serious burden, even if the members are directed to independent and distinct inventions. If the claims were restricted to nucleotides and nucleosides, there would only be two species. Furthermore, a search of nucleotides and nucleosides would be expected to be largely coextensive given the

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similarity in chemical structure. Therefore, it is requested that the claims at least be searched and examined with respect to both nucleotides and nucleosides.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



Scott L. Ausenhus
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